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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,987	12/05/2003	Dickory Rudduck	112427.132US1	7249
28089	7590	09/16/2005	EXAMINER	
WILMER CUTLER PICKERING HALE AND DORR LLP			YIP, WINNIE S	
399 PARK AVENUE			ART UNIT	
NEW YORK, NY 10022			PAPER NUMBER	
			3637	

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/727,987

Applicant(s)

RUDDUCK ET AL.

Examiner

Winnie Yip

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 30-38 and 40-47 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-38 and 40-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date June 30, 2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Part II DETAILED ACTION

This office action is in response to applicant's amendment filed on June 30, 2005.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 7-29 and 39 have been canceled, and claims 1-6 and 30 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on November 19, 2004.

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Australia on June 7, 2001. It is noted, however, that applicant has not filed certified copies of the Australia applications PR 5540 and PR 5541 and PCT/AU02/00747 as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 45-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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In these claims, the newly amended features of “the joining clip is made of a rigid material” (claim 45) and “of a stainless steel” (claim 46) were not supported by the disclosure as original filed. According to the specification, page 7, lines 23-24, “both the first and second parts (of the joining clip) are made of relatively resilient material”. And, the original claims only claim the building element” being made of a rigid material/or a stainless steel, but not the joining clip.

An appropriate correction is required.

Due to the confusion, the claims 45-46 have not been treated on the merits.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 42 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claimed language “the second part has a protrusion adapted to snap into or slide into a channel on the first part” does not appear to consist with the body of the claimed invention. According to the specification and the drawing, the second part (117) having a pair of resilient arms (114a, 11b) (a protrusion?) adapted to snap into or slide into a channel on the building element but not “the first part” as claimed. The specification fails to provide a support to define the second part (117) having a protrusion snap into or slide into a channel of the first part (115). An appropriate correction is required.

Claim Rejections - 35 USC § 102

6. Claims 31-33, 35, and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Rinaldi (US Patent No. 4,841,688).

Rinaldi teaches a building element being capably used for a stud or mullion, the building element (6) may include two or more arms connected together at an angle and lied in one or more planes (see Fig. 3), the building element (26) (see Figs. 5 and 8) comprising a first and second sets of three channels (8, 24, 8; 7, 24, 7), the fist and second sets of channels being spaced apart from one to other by first and second webs (25), the fist and second webs being parallel to each another, each of the channel having a base (24) between a pair of resilient channel side walls, the bases of the first and second set of channels being aligned, and the channel side walls formed by resilient arms for capably receiving a co-operating means such as a clip (31) for mounting a panel or bracket on the building element, and wherein the building element is a unitary structure.

7. Claims 31- 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Pollard (US Patent No. 3,866,364).

Pollard shows and discloses a building element being capably used for a stud or mullion, the building element may includes two or more arms (11) being connected together at an angle with respect to each other and being lied in more than one plane (see Fig. 35), wherein the building element may include two arms being connected to the building element at an angle of 90 degree (see Fig. 16) and lied in one plane, or may have three arms to form a T shape configuration (see Figs. 18-19), or may have four arms to form a cruciform shape; and wherein

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the building element is a unitary structure comprises a first set of three channels and a second set of three channels, the first and second sets of channels being spaced apart from one to other by first and second webs (17, 17), the first and second webs (17, 17) being parallel to each another, each of the channel having a base (13, 14) and two sides formed by resilient arms (19, 12, 22; or 21, 14, 23) which provide means for receiving a co-operating means for mounting a panel (26) or bracket (86) to the building element.

8. Claims 31-36, and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Gassler (US Patent No. 4,388,786).

Gassler shows and discloses a building element (13, 14) being capably used for a stud or mullion, the building element may include a vertical stud with a square configuration (see Figs 4-5) and two or more arms (13,14) connected together at an angle such as a 90 degrees and may be lied in one or more planes (see Fig. 1), or the building element may have three arms to form a T shape configuration; wherein, each of the building elements has a profile comprising a first set of three channels (12) and a second set of three channels (12) on opposite sides of the profile, the first and second sets of channels (12, 12) being spaced apart from one to other by first and second webs (i.e., 71, 71), the first and second webs (71, 71) being parallel to each another, each of the channel (12) having a base (i.e., 72) and a pair of channel side walls formed by resilient arms (45, 11, 46) (see Figs. 4-5, 8-9, and 12-15), wherein the channel having flexible projections on the ends that are capable to receive a co-operating means (28) for securing the arms (13, 14) or securing a panel or bracket to the building element.

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9. Claims 40-44 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller (US Patent No. 3,053,353).

Miller shows and discloses a building element used for a mullion, the building element (i.e., 16) including at least one set of three channels, the channel formed by an aligned base (44) and two adjacent sides (46, 56, 54, 48), the adjacent sides having protrusions (52, 56, 54, 50) for receiving a co-operating means, a joining clip being made of rigid material such as aluminum and having two separated parts (40, 42) including a first longitudinally extending part (40) and a second longitudinally extending part (42), wherein the second longitudinally extending part (42) including a pair of resilient arms (78, 80) providing co-operating means that contains protrusions to complement grooves (52) in the side walls (46, 48) of the channels in the building element and to snap into the channels in the building element, and a channel formed by a pair of arms (74, 76); and the first longitudinal extending part (40) having two resilient arms (60, 61) having protrusions (62, 64) snapping into the channel on the first part (42), the first longitudinal extending part (40) having a channel to receive a fasteners (100) for providing means for connecting the jointing clip to a panel (22) and having two engaging surfaces (72) proofing a seal between the joining clip with the panels and the building element.

Claim Rejections - 35 USC § 103

10. Claims 31-38, 40-44, and 47 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hsueh (US Patent No. 5,996,299) in view of Mamane (PCT NO. WO 95/27834).

Hsueh shows and teaches a building element being used for a stud or mullion, the building element (1) being made of rigid material such as stainless steel, the building element (1) comprising a first and second sets of three channels (14, 15, 14) being spaced apart from one to

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other by a web (11), each of the channel (14) having a base (14) and a pair of sides (144) to receive a co-operating means for mounting a panel (2) on the building element, the channels substantially lie in a same plane, said co-operating means including a joining clip having two separated parts (4, 3), the first longitudinally extending part (3) including a pair of resilient arms (31) being snap engaged with the channel (14) of the building element, and having a base receiving bolts passed therethrough holes (33, 21) for providing means to connect the joining clip to a panel (2), and the second longitudinally extending part (4) having a pair of resilient arms (41) being snap into the channel (14) of the building element for providing co-operating means and having a protrusion (42) being inserted into the channel of the first longitudinal extension part (3) to receive fasteners (21) passed therethrough for providing means connecting the panel (2) to the building element (1). Hsueh does not define the building element (1) having two webs extending between the sets of channels. Mamane teaches a building element (1, 2) used for a stud or a mullion, the building element having two sets of channels being spaced apart by two parallel webs (2d, 2c; 2a, 2b) on either sides to define a central tubular area (4) therebetween for receiving a co-operating means (6) through the base of channels without affecting the strength of the webs extending between the bases of the channels. Therefore, it would have been obvious to one ordinary skill in the art, at the time the invention was made, to modify the building element of Hsueh having more than one web provided between two sets of channels as taught by Mamane for receiving fasteners and maintaining the strength of the building element to provide a stronger support for the building structure.

Regard to claims 33-38, although Hsueh does not define the building element including at least two arms being connected at an angle or lie in more than one plane as claimed. Mamane

teaches the building element may including at least two arms (1, 2) being connected together at a 90 degrees and lie in a same plane, the arms (1, 2) would be connected in a T shape configuration. It would have been obvious to one ordinary skill in the art, at the time the invention was made, to modify the building element of Hsueh having a plurality of arms being connected together in different plane as taught by Mamane for connecting more than one panels to the building element.

Response to Argument

11. Applicant's arguments with respect to claims 31-38 and 40-47 under U.S.C. 102, and specifically to the feature for the building element being "a unitary structure" has been considered. This feature was not specifically and previously claimed in claim 31. Therefore, the rejections to claims have been withdrawn and the argument is deemed to be moot in view of the new grounds of rejection.

12. In response to applicant's argument that there is no suggestion to combine the references of Hsueh '299 with Mamane (WO 95/27834), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, first, in response to applicant's argument that Hsueh '299 does not suggest to require two webs to increase the strength of the support of the building element, we agree that this is so, otherwise our rejection would have been entered under

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section U.S.C. 102 of the statute. However, Hsueh and Mamane both teach a building element having channels for receiving joining clips to support panels thereon. Although Hsueh does not directly suggest the building element (1) require additional webs, Mamane is used as a teaching reference to teach a building element would provide more than one webs to form a tubular space therebetween to receive a fastener (i.e. 6) without penetrating the webs to maintain the strength of the building element as solve the same problem as the claimed invention as disclosed in the specification. Since the references in the same art, it would have been obvious to one ordinary skill in the art to modify the building element of Hsueh with more than one web as taught by Mamane to achieve the improvement for such application as claimed invention. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

ACTION IS FINAL

13. Applicant's amendment necessitated the new grounds of rejection. Accordingly, THIS ACTION IS MADE FINAL. See M.P.E.P. ' 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. ' 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. ' 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY

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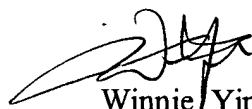
ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Inquiry Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Winnie Yip whose telephone number is 571-272-6870. The examiner can normally be reached on M-F (9:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

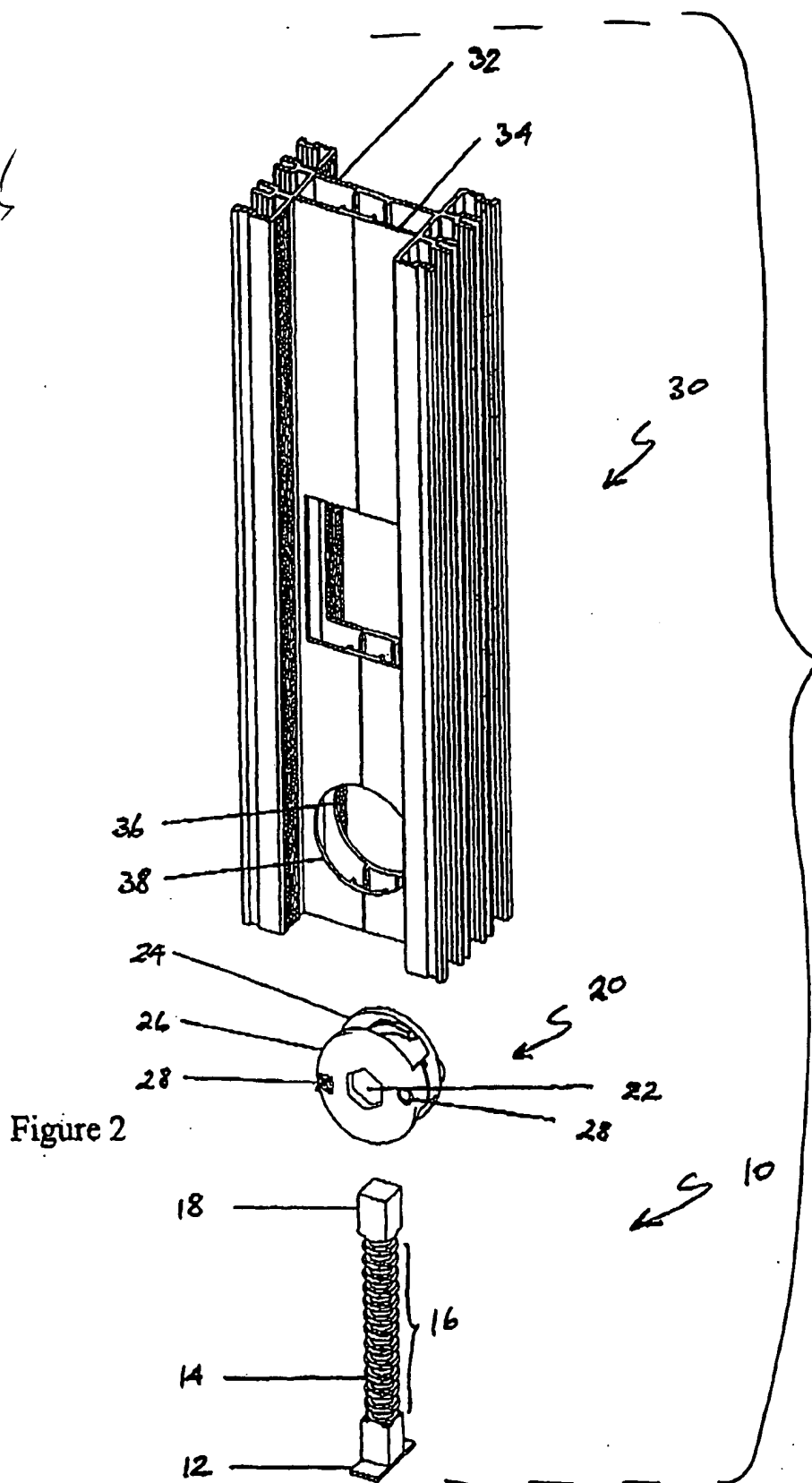
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Winnie Yip
Primary Examiner
Art Unit 3637

wsy
September 13, 2005

REPLACEMENT SHEET



REPLACEMENT SHEET

approved
no 9/13/25

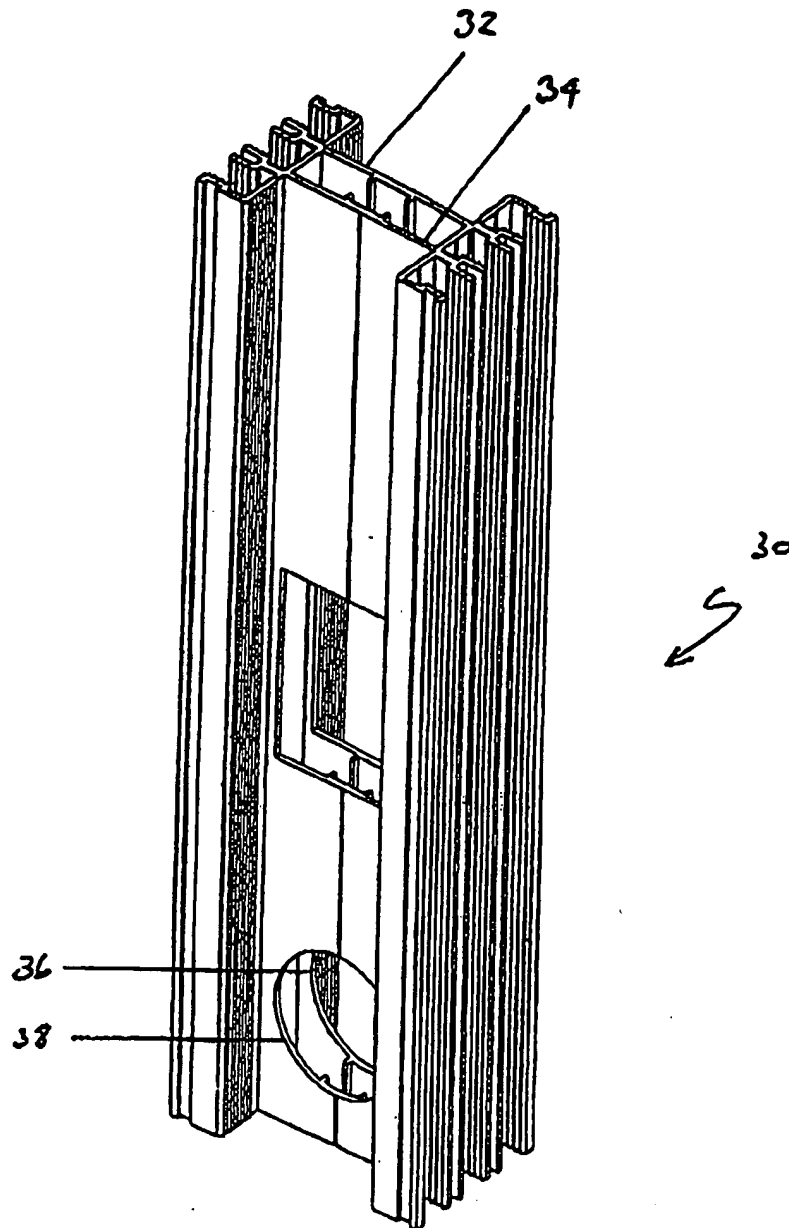
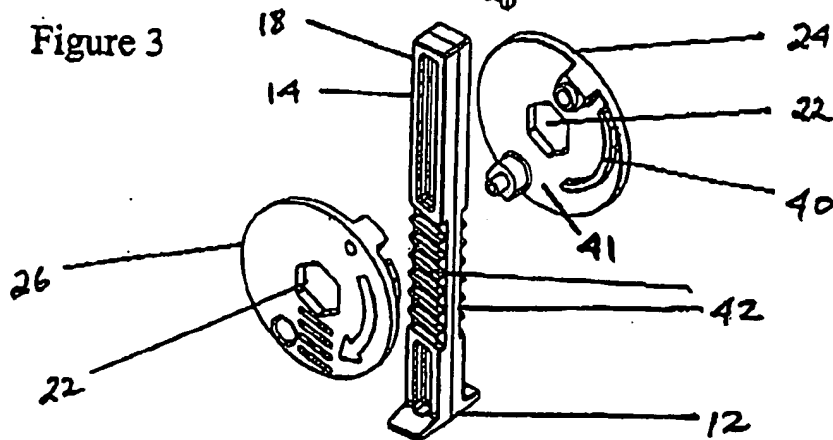


Figure 3



approved
w/ 9/13/05

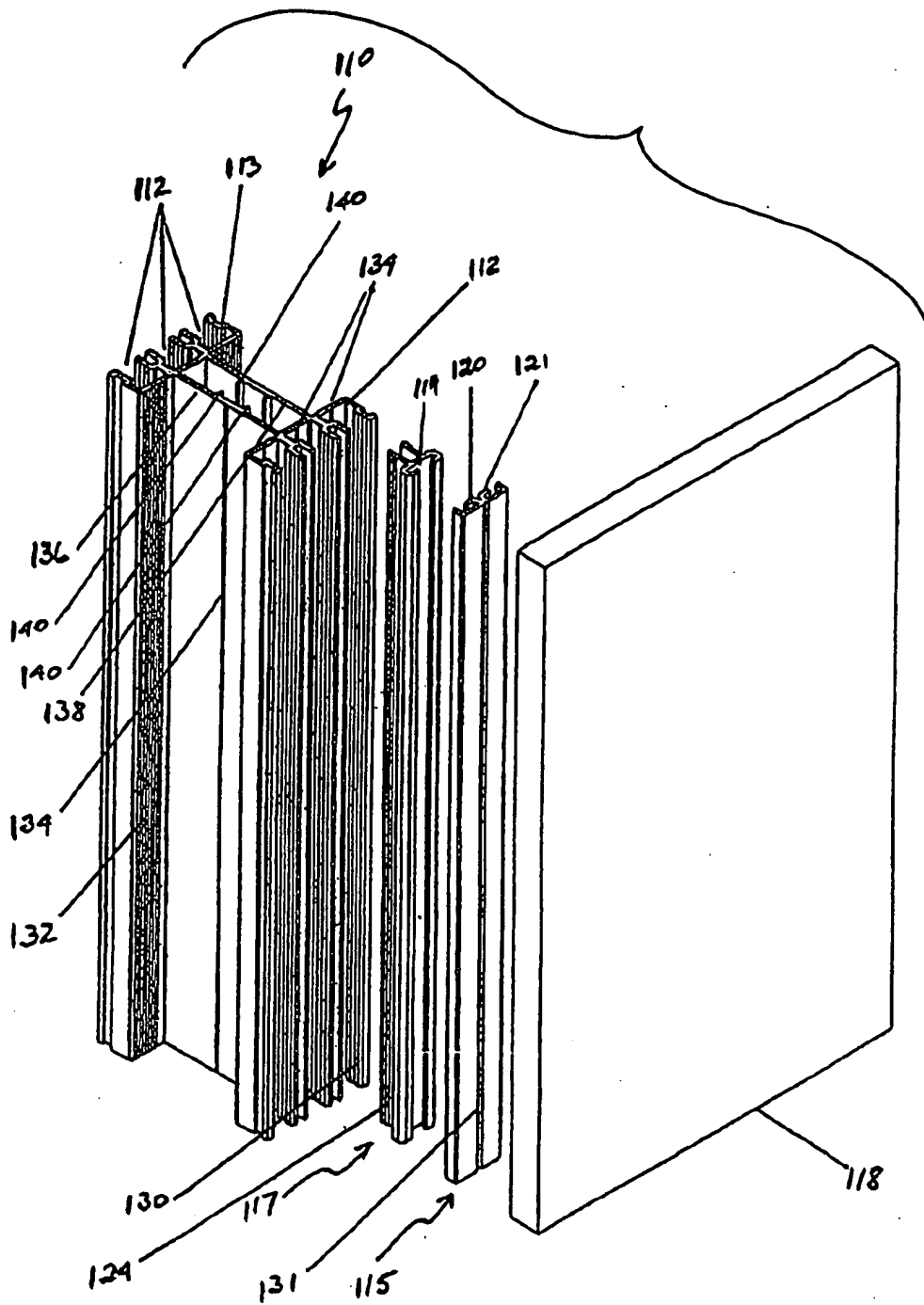


Figure 13